

Pat. No. 5,852,812) and Official Notice. The Examiner rejected claims 62 and 63 under 35 U.S.C. § 103(a) as being unpatentable over Wood et al. (U.S. Pat. No. 5,891,035) in view of Reeder (U.S. Pat. No. 5,852,812) and Wyman (U.S. Pat. No. 5,260,999). The Examiner rejected claim 67 under 35 U.S.C. § 103(a) as being unpatentable over Wood et al. (U.S. Pat. No. 5,891,035) in view of Reeder (U.S. Pat. No. 5,852,812) and Clarke et al. (U.S. Pat. No. 5,982,917).

Claim 59 and the Claims Depending Therefrom

Claim 59 recites:

A method for providing operational protocols to medical diagnostic systems, the method comprising the steps of:

storing a protocol on a machine readable medium, the protocol including at least one operating parameter for a medical diagnostic system;

displaying user viewable indicia descriptive of the protocol at a medical diagnostic location, wherein the user viewable indicia include an exemplary image obtainable via the protocol;

performing a protocol exchange transaction including selecting the protocol via a user interface and loading the protocol at the medical diagnostic location from the machine readable medium via a network connection to the medical diagnostic location; and

storing an accounting record of the transaction.

The Applicants respectfully traverse rejection of claim 59 and its dependent claims. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a

convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

The Examiner's rejection fails because the combination of references does not render the recited features obvious for at least three reasons. First, the combination fails to include all of the recited features, such as the claimed "displaying user viewable indicia descriptive of the protocol at a medical diagnostic location, wherein the user viewable indicia include an exemplary image obtainable via the protocol." Second, the Reeder reference is non-analogous art. Third, the Examiner has failed to provide support for a motivation or a suggestion to combine the references.

Recited Features Missing from Claim 59 and the Claims Depending Therefrom

Applicants contend that the Examiner's rejection fails because the reference fails to disclose all of the subject matter recited in claim 59. In the rejection, the Examiner admitted that the Wood et al. reference does not expressly disclose that "the user viewable indicia include an exemplary image obtainable via the protocol." Yet, the Examiner *presumes* that the Wood et al. reference discloses the "exemplary images obtainable via the protocol" from passages in the Wood et al. reference. However, the reference is devoid of any suggestion of the recited feature.

The Wood et al. reference is directed to enabling ultrasound systems to communicate on a network. Wood et al., col. 2, lines 20-29. In the passages cited by the Examiner, the accessing of an image library 400 to find a type of pathology or condition for a patient's condition is disclosed. Wood et al., col. 10, lines 8-15. These images are used to aid in making diagnoses, not for *displaying images obtainable via the protocol*. In fact, the selection process for the images is based on pathologies and conditions, which are related to aiding the diagnosis of the patient's condition. Wood et al., col. 10, lines 19-22. Accordingly, the Wood et al. reference does not disclose the recited feature of independent claim 59.

The Examiner relies on the Reeder reference to disclose "storing an accounting record of the transaction." However, the reference does not cure the deficiencies of the Wood et al. reference. The Reeder reference is directed to an online billing system for exchanging international currency from credit card transactions. Reeder, col. 2, lines 36-44. In fact, the reference does not disclose diagnostic systems or anything related to the medical field. Clearly, the reference solely discloses a billing system, and does not even mention a *protocol*, much less "an exemplary image obtainable via a protocol." Thus, the Reeder reference does not disclose all of the recited features and fails to cure the deficiencies of the Wood et al. reference.

Furthermore, Applicants respectfully request the Examiner to provide support under M.P.E.P. § 2144.03 for the Examiner's apparent assertion of what is "well known in the art" (see the passage referring to "presumably via a protocol"). It is apparent in the rejection of the claims that the Examiner has made a significant logical leap from the actual teachings of the references, to summarily declare the recited claims obvious without proper support for the apparent teachings, suggestions, and "well known" elements of the prior art. In the rejection, the Examiner has asserted that various recited features are obvious because they are presumed and has taken Official Notice of facts outside of the record that the Examiner apparently believes are capable of demonstration as being "well-known" in the art.

Therefore, in accordance with M.P.E.P. § 2144.03, Applicants hereby seasonably traverse and challenge the Examiner's use of Official Notice. Specifically, Applicants respectfully request that the Examiner produce evidence in support of the Examiner's position as soon as practicable during prosecution and that the Examiner add a reference to the rejection in the next Official Action. If the Examiner finds such a reference and applies it in combination with the Wood et al. and Reeder references, Applicants further request that the Examiner specifically identify the portion of the newly cited reference that discloses the allegedly "well known" elements of the recited claims, as discussed above, or withdraw the rejection.

Reeder Reference is Non-analogous Art

Furthermore, because the Reeder reference is non-analogous art, it is not a proper basis for the rejection. For the teachings of a reference to be prior art under 35 U.S.C. § 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the particular problem with which the invention pertains. *In re Horne*, 203 U.S.P.Q. 969, 971 (C.C.P.A. 1979). Non-analogous art cannot properly be pertinent prior art under 35 U.S.C. § 103. *In re Pagliaro*, 210 U.S.P.Q. 888, 892 (C.C.P.A. 1981). The determination of whether a reference is from a non-analogous art is set forth in a two-step test given in *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 220 U.S.P.Q. 584 (Fed. Cir. 1984). In *Union Carbide*, the court found that the first determination was whether "the reference is within the field of the inventor's endeavor." If it is not, one must proceed to the second step "to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved." In regard to the second step, *Bott v. Fourstar Corp.*, 218 U.S.P.Q. 358 (E.D. Mich. 1983) determined that "analogous art is that field of art which a person of ordinary skill in the art would have been apt to refer in attempting to solve the problem solved by a proposed invention." "To be relevant the area of art

should be where one of ordinary skill in the art would be aware that similar problems exist.” *Id.*

The field of endeavor of the Application, and particularly claim 59, is providing protocols for medical diagnostic imaging systems. Reeder is not even remotely related to that field. The Reeder reference is directed to an online billing system for exchanging international currency from credit card transactions. Reeder, col. 2, lines 36-44. The billing system resolves pricing and billing issues for international customers by relating the transaction to local currency from a single credit card processor. Reeder, col. 2, lines 16-26. Indeed, the reference is solely related to a billing system that produces local currency bills and does not even disclose a diagnostic systems or anything related to the medical industry, much less to protocols used on such systems. Considering, then, the second prong of the *Union Carbide* test, it must be determined whether the reference is reasonably pertinent to the problem addressed by the invention. Clearly, it is not. Reeder teaches nothing even remotely pertinent to distribution of imaging protocols. Thus, the reference fails the *Union Carbide* test, and is not analogous art that can support a rejection of claim 59.

No Motivation or Suggestion to Combine the References

Additionally, the Examiner has failed to point to a convincing line of reasoning to support a suggestion or motivation to combine or to modify the Wood et al. reference or the Reeder reference. Indeed, the Examiner has failed to meet the required burden of articulating a motivation for the combination of Wood et al. and Reeder.

Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention for the user viewable indicia to include an exemplary image obtainable via the protocol, for the stated advantages of aid in making a diagnosis from images obtained by the diagnostic system, and training new diagnostic system users, and for the obvious advantage of demonstrating what the protocol can do.

The Examiner's statement is nothing more than an unsupported assertion about the teachings of Wood et al. and Reeder, not a convincing line of reasoning *why* one of skill in the art would combine the references. The Federal Circuit recently overturned the Board, which had upheld an examiner's rejection in a similar situation. In the case of *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002), the examiner rejected the applicant's claims under 35 U.S.C. § 103 without giving the supporting motivation to combine references. The Board subsequently affirmed the examiner's rejection. In overturning the Board's decision, the Federal Circuit stated that:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors').

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on *objective evidence of record*. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [citations omitted]. *In re Lee*, 61 U.S.P.Q.2d 1430, at 1433 (emphasis added).

In the present case, the Examiner's unsupported assertion does not meet the evidentiary standard required for combining references under Section 103. Indeed, the Examiner has impermissibly relied on hindsight, using the teachings of Applicants to find the suggestion to combine the alleged teachings of Wood et al. and Reeder. The Wood et al. reference is directed to providing an ultrasound diagnostic imaging system with communication capability. Wood et al., col. 2, lines 30-33. Indeed, the communications disclosed by Wood et al. relate to patient diagnostic and system presets. Wood et al., col. 7, lines 20-27, and col. 10, lines 19-22. The system

presets simply allow an ultrasonographer to use the same preferred system presets, while the patient diagnostic images relate pathologies and conditions for patient diagnosis. Wood et al., col. 7, lines 20-22, and col. 10, lines 12-15. The Reeder reference is directed to an online billing system for exchanging international currency from credit card transactions. Reeder, col. 2, lines 36-44. The billing system resolves problems relating to pricing and billing international customers in local currency from a single credit card processor. Reeder, col. 2, lines 16-26. However, the reference does not disclose diagnostic systems or anything related to the medical industry. In the rejection, the Examiner has not pointed to any suggestion in the references or in any other art of record for a suggestion or a motivation to combine these references. Thus, as the references are unrelated and do not provide support for the proposed combination, the Examiner's rejection as based on the proposed combination is unsupported and cannot stand.

Accordingly, the cited references fail to disclose *all* of the recited features of the instant claim and the Examiner's suggested combination is improper. Because the Examiner has failed to show that the cited references disclose *all* of the recited features, as well as a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the cited reference, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, independent claim 59 and its respective dependent claims 60-64 and 66-68 are believed to be patentable over Wood et al. and Reeder.

II. Second Rejection Under 35 U.S.C. § 103

Summary of the Invention

The Examiner rejected claims 69 and 71-73 under 35 U.S.C. § 103(a) as being unpatentable over Wood et al. (U.S. Pat. No. 5,891,035) in view of Reeder (U.S. Pat. No. 5,852,812) and Official Notice. Further, the Examiner rejected claim 70 under 35 U.S.C.

§ 103(a) as being unpatentable over Wood et al. (U.S. Pat. No. 5,891,035) in view of Reeder (U.S. Pat. No. 5,852,812), Official Notice, and admitted prior art. Applicants respectfully traverse the rejection.

Claim 69 and the Claims Depending Therefrom

Claim 69 recites:

A method for obtaining an operational protocol for a medical diagnostic system or institution, the method comprising the steps of:

ordering a protocol by viewing a protocol list on a user interface at the medical diagnostic system or institution, and selecting a desired protocol from the list, wherein the protocol list includes an exemplary image obtainable via the protocol;

performing a transaction by accessing data from a protocol library defining the desired protocol via a network link between the diagnostic system or institution and the library, and transmitting the data from the library to the diagnostic system; and

storing a record of the transaction.

The Examiner's rejection fails because the combination of references does not render the recited features obvious for at least three reasons. First, the combination fails to include all of the recited features of claim 69. Among these missing features are "ordering a protocol by viewing a protocol list on a user interface at the medical diagnostic system or institution," "selecting a desired protocol from the list," and "wherein the protocol list includes an exemplary image obtainable via the protocol." Second, the Reeder reference is non-analogous art. Third, the Examiner has failed to provide support for a motivation or suggestion to combine the references.

As a preliminary matter, in the rejection, the Examiner admitted that the Wood et al. reference does not expressly disclose some of the recited features. Yet, in the rejection, the Examiner asserted that the Wood et al. reference disclosure "comes close." That will not do. Applicants are not aware of a "comes close" legal standard for

obviousness, and respectfully traverse the Examiner's assertion. Applicants respectfully contend that the recited features are not disclosed by the Wood et al. reference.

Recited Features Missing from Claim 69

The Examiner's rejection fails because the references fail to disclose all of the subject matter recited in claim 69. In the rejection, the Examiner admitted that the Wood et al. reference does not expressly disclose the recited features of "ordering a protocol by viewing a protocol list on a user interface at the medical diagnostic system or institution," "selecting a desired protocol from the list," and "wherein the protocol list includes an exemplary image obtainable via the protocol," as recited in claim 69. However, the Examiner asserted that the Wood et al. reference's disclosure along with the Official Notice render the recited features obvious. Specifically, in the rejection, the Examiner asserted that the referencing of presets from an HTML page "comes close." As discussed above, the Wood et al. reference is directed to enabling the ultrasound systems to communicate on a network. Wood et al., col. 2, lines 20-29. In the cited passages, the references to the presets merely allows the ultrasonographer to access system setting without having to manually try to duplicate an exam done elsewhere. Wood et al., col. 7, lines 20-26. The presets are merely the user's system setup. Furthermore, as discussed above, the Wood et al. reference does not relate presets with the "an exemplary image obtainable via the protocol," as recited in the claim. Indeed, the Wood et al. reference fails to disclose even associating *exemplary images* with the presets. Accordingly, the Wood et al. reference does not disclose or teach all of the recited features of independent claim 69.

While the Examiner relies on the Reeder reference to disclose "storing a record of the transaction," the reference does not cure the deficiencies of the Wood et al. reference. Again, the Reeder reference is directed to an online billing system that exchanges international currency for credit card transactions. Reeder, col. 2, lines 36-44. No mention, of course, is made to a *diagnostic system*, much less a *protocol* or the recited features of

“ordering a protocol by viewing a protocol list on a user interface at the medical diagnostic system or institution,” “selecting a desired protocol from the list,” and “wherein the protocol list includes an exemplary image obtainable via the protocol.” Thus, the Reeder reference does not cure the deficiencies of the Wood et al. reference and what the Examiner would presume by Official Notice.

Furthermore, here again, Applicants respectfully request the Examiner to provide support under M.P.E.P. § 2144.03 for the Examiner’s apparent assertion of what is “well known in the art.” Applicants hereby seasonably traverse and challenge the Examiner’s use of Official Notice, and request that the Examiner produce evidence in support of the Examiner’s position as soon as practicable during prosecution and that the Examiner add a reference to the rejection in the next Official Action. If the Examiner finds such a reference and applies it in combination with the Wood et al. and Reeder references, Applicants further request that the Examiner specifically identify the portion of the newly cited reference that discloses the allegedly “well known” elements of the recited claims, as discussed above, or withdraw the rejection.

Reeder Reference is Non-analogous Art

Moreover, as discussed above, the Reeder reference is non-analogous art that would not be considered by one skilled in the particular art working on the particular problem with which the invention pertains. Again, the Reeder reference is directed to the problem of pricing and billing international customers at local currency from a single credit card processor. Reeder, col. 2, lines 16-26. Accordingly, as the Reeder reference fails the *Union Carbide* test, as summarized above. Thus, the Reeder reference is non-analogous and the Examiner’s inclusion of the Reeder reference is improper because the reference cannot be pertinent prior art under 35 U.S.C. § 103.

No Motivation or Suggestion to Combine the References

Additionally, the Examiner has failed to provide a convincing line of reasoning to support a suggestion or motivation to combine or to modify the Wood et al. reference or the Reeder reference. Indeed, the Examiner has failed to meet the required burden of articulating a motivation for the combination of Wood et al. and Reeder. The Examiner stated simply:

Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention for the protocol list to include an exemplary image obtainable via the protocol, for the stated advantages of aid in making a diagnosis from images obtained by the diagnostic system, and training new diagnostic system users, and for the obvious advantage of demonstrating what the protocol can do.

The Examiner's conclusory statement is nothing more than an unsupported assertion about the teachings of Wood et al. and Reeder, not a convincing line of reasoning *why* one of skill in the art would combine the references. The Examiner's statement does not meet the evidentiary standard required for combining references under Section 103. Again, the Examiner has relied on hindsight, using the teachings of Applicants to find the suggestion to combine the alleged teachings of Wood et al. and Reeder.

Accordingly, the cited references fail to disclose *all* of the recited features of the instant claim and the Examiner's suggested combination is improper. Therefore, independent claim 69 and its respective dependent claims 70-73 are believed to be patentable over, and their reconsideration and allowance are requested.